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Docket No.: PF306D1

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Olsen et al.

Application No.: 09/899,917

Group Art Unit: 1653

Filed: July 9, 2001

Examiner: K. Carlson

For: Human Oncogene Induced Secreted Protein I

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, DC 20231

Dear Sir:

The Office Action mailed September 19, 2002 divides pending claims 17-116 into two groups and requires Applicants' election of one of the groups for further prosecution. Group I corresponds to claims 17-28, 30-36, 38-47, 49-53, 55-59, 61-74, 76-81, 83-90, 92-99, 101-107, 109-114, and 116, drawn to proteins. Group II corresponds to claims 29, 37, 48, 54, 60, 75, 82, 91, 100, 108, and 115, drawn to methods for producing proteins. Applicants provisionally elect with traverse the subject matter of Group I and reserve the right to file one or more divisional applications directed to non-elected subject matter should the restriction requirement be made final.

The Office Action states as reason for the restriction that Groups I and II are related as process of making and product made. More specifically, the proteins of Group I can allegedly be made by a materially different process than the methods of Group II, namely by "traditional synthetic protein synthesis." However, since the only realistically searchable features of the method claims of Group II are the characteristics of the protein produced, the search of Groups I

and II would largely, if not entirely, overlap. Furthermore, it is highly unlikely that any prior art exists concerning "traditional synthetic protein synthesis" of the proteins recited by the method claims of Group II since the proteins recited therein were unknown prior to their invention by Applicants. Thus, Applicants believe that once a search has been conducted of the proteins of Group I, no further search will be required in order to consider the methods of Group II.

Furthermore, since the claims of Groups I and II are related as between a product and a process for producing the product, and the process claims include all the limitations of the product, the Examiner in any case would be obligated to rejoin the method claims if the elected product claims are found allowable. In light of the decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996), a notice was published in the Official Gazette which set forth new guidelines for the treatment of product and process claims. *See* 1184 OG 86 (March 26, 1996). Specifically, the notice states that "in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim." *Id.* Accordingly, Applicants respectfully request that if any of the claims of Group I are found allowable, the process claims of Group II be rejoined and examined for patentability.

Even assuming, *arguendo*, that Groups I and II represent distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of both groups would entail a "serious burden." *See* M.P.E.P. § 803. In the present situation, no such showing has been made.

Thus, Applicants respectfully request that the restriction requirement be withdrawn and that the subject matter of claims 17-116 be examined together.

It is believed that no fees are required for entry of this response. However, if there are any fees due in connection with the filing of this paper, please charge the appropriate fees to our Deposit Account No. 08-3425.

Dated: *11-17-00*

Respectfully submitted,

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